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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF:

Burkhard STANDKE, et al.

SERIAL NO.: 09/987,268

FILED: NOVEMBER 14, 2001

FOR: N-PROPYLETHOXYSILOXANES, THEIR PREPARATION AND USE

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: GROUP ART UNIT: 1762

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: EXAMINER: CAMERON

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RESPONSE TO RESTRICTION AND ELECTION OF SPECIES REQUIREMENT

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

SIR:

In response to the Official Action dated June 28, 2002, Applicants elect, with traverse, Group I, Claims 1-16, 23, 25 and 27-35. In addition, Applicants elect, with traverse, mineral building materials (see page 11, second paragraph) as a Species of the invention. Claims 1-40 read on the elected Species.

REMARKS

The Office has restricted this application as follows under 35 U.S.C. §121:

Group I: Claims 1-16, 23, 25 and 27-35, drawn to a composition; and

Group II: Claims 17-22, 24, 26 and 36-40, drawn to a method of coating.

In addition, the Examiner is requiring an election of a single disclosed Species of substrate.

Applicants elect, with traverse, Group I, Claims 1-16, 23, 25 and 27-35. In addition, Applicants elect, with traverse, mineral building materials (see page 11, second paragraph) as a Species of the invention. Claims 1-40 read on the elected Species.

Applicants note that the claims of Group II directly depend from the claims of Group I, and as such it is improper to separate these claims.

In regard to Group I and Group II, the Office has characterized the relationship between these two groups as product and process of use. Citing MPEP §806.05(h), the Office concludes that the product can be used in a materially different process such as "being extruded into a free-standing sheet." However, the claims of Group II directly depend from the claims of Group I, and as such the product of Group I *is* used in the process of Group II. Moreover, the Office has not provided sufficient reasons and/or examples to support this conclusion. Further, the Office has failed to show that the proposed process is materially different from the claimed process. Accordingly, Applicants respectfully submit that the Office has failed to meet the burden necessary in order to sustain the Restriction Requirement. Withdrawal of the Restriction Requirement is respectfully requested.

Applicants traverse the Restriction Requirement on the grounds that the Office has not shown that a burden exists in searching all the claims of the present application.

Moreover, MPEP §803 states as follows:

If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on its merits, even though it includes claims to distinct or independent inventions.

Applicants submit that a search of all claims would not constitute a serious burden on the Office.

Applicants respectfully traverse the Election of Species Requirement on the grounds that the Office has not provided any reasons, whatsoever, to support the conclusion of patentable distinctness. Rather, the Office has merely stated the conclusion.

Applicants make no statement regarding the patentable distinctness of the species, but note that for restriction to be proper, there must be a patentable difference between the

species as claimed. MPEP §808.01(a). The Office has not provided any reasons or examples to support a conclusion that the species are indeed patentably distinct. Accordingly, Applicants respectfully submit that the restriction is improper, and Applicants' election of species is for examination purposes only.

Finally, with respect to the elected species, Applicants respectfully submit that, should the elected species be found allowable, the Office should expand its search to the non-elected species.

Accordingly, and for the reasons presented above, Applicants submit that the Office has failed to meet the burden necessary in order to sustain the Restriction and Election of Species Requirement. Withdrawal of the Restriction and Election of Species Requirement is respectfully requested.

Additionally, MPEP §821.04 states:

...if applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined.

Applicants respectfully submit that should the elected group be found allowable, non-elected process claims should be rejoined.

Applicants respectfully submit that the above-identified application is now in
condition for examination on the merits, and early notice of such action is earnestly solicited.

Respectfully submitted,

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